

REMARKS

This application has been carefully reviewed in view of the Office Action mailed October 16, 2008. All rejections are respectfully traversed and reconsideration is respectfully requested.

Claims 1-38 are pending in the present application. Claims 11, 14-17, 24, 26, 35, and 36 are cancelled. Claims 39-41 are added. Accordingly, claims 1-10, 12, 13, 18-23, 25, 27-34, and 37-41 are pending.

In this Amendment, Applicant has amended claims 1, 3, 6, 8, 10, 12, 13, 21, 22, 25, 28, 29, 32, 37, and 38 and cancelled claims 11, 14-17, 24, 26, 35, and 36 from further consideration in this application. Applicant is not conceding that the subject matter encompassed by claims 1, 3, 6, 8, 10, 12, 13, 21, 22, 25, 28, 29, 32, 37, and 38 and claims 11, 14-17, 24, 26, 35, and 36 prior to this Amendment is not patentable over the art cited by the Examiner. Claims 1, 3, 6, 8, 10, 12, 13, 21, 22, 25, 28, 29, 32, 37, and 38 were amended and claims 11, 14-17, 24, 26, 35, and 36 were cancelled in this Amendment solely to facilitate expeditious prosecution of the present application. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by claims 1, 3, 6, 8, 10, 12, 13, 21, 22, 25, 28, 29, 32, 37, and 38 and claims 11, 14-17, 24, 26, 35, and 36 as presented prior to this Amendment and additional claims in one or more continuing applications.

Claim Amendment Corrections

In reviewing the file history, Applicant noted that certain amendments to the claims presented within a preliminary amendment filed March 21, 2006 were inadvertently not represented within the response to the last Office Action dated April 7, 2008, filed on June 23, 2008. Applicant has corrected the claims for consistency with the preliminary amendment herein without edit markings so that present amendments may be readily distinguished from previously made amendments. Applicant apologizes for any inconvenience that this may have caused.

Regarding the Information Disclosure Statements

Applicant appreciate the Examiner's indication that the information disclosures statements (IDSs) filed are in compliance with the provisions of 37 C.F.R. 1.97. Applicant also

appreciates the Examiner's consideration of most of the references submitted in this application and regrets the need to submit such a large number of references. As Applicant indicated in the previous Response to Office Action filed June 23, 2008, those references considered are believed to include those of most relevance. Applicant requests reconsideration of the reference citations that have not been considered for the following reasons.

Applicants' sincerely regret the burden that submission of this large number of references places on the Examiner. The reason for such a large number of reference citations is that Applicants' assignees have filed in excess of forty patent applications, most of which have foreign counterparts, which relate generally to selective encryption, multiple selective encryption, PID mapping, VOD applications of selective encryption, content substitution and related technologies. These applications share a number of common inventors and have been prepared and filed by three separate patent prosecution firms and have been extensively licensed. The references which have been submitted represent a compilation of all art identified in a) multiple searches of the basic technologies, b) technology known to the Applicants, c) results of searches conducted by examiners in individual U.S. applications, d) search results from the PCT, and foreign patent offices, e) publications of applications related to this technology filed by Applicants' assignees, and searches conducted on individual aspects of the various inventions. Compilation and maintenance of this large list of references is also extraordinarily costly and burdensome on the undersigned and the Assignee.

The need for such extensive disclosures was discussed in a meeting in which Group Director Paul Sewell as well as three SPEs attended with the undersigned along with Mr. Fred Zustak, Esq. and Mr. John Rogitz, Esq. on April 12, 2005. This meeting was requested by Applicants' representatives in part due to their understanding of the burden of submission of large numbers of references and filing of a large number of related applications. An offer was extended at that time to meet with a team of examiners to provide information to assist in their examination or to otherwise provide assistance in any way the USPTO Management deemed appropriate. Applicants' representatives suggested interviews prior to first office actions and further suggested that the number of examiners be limited to enhance efficiency and limit uncovering redundant references. Those offers and suggestions were declined.

While the undersigned appreciates that the large number of references presented is burdensome, the undersigned submits that the current duty of disclosure rules and proliferation of charges of inequitable conduct place Applicants' representatives in a no-win situation when it comes to satisfying the duty of disclosure. If all references are submitted, a litigator will no doubt charge that Applicants have attempted to hide the relevant art in a "mountain" of less relevant material. If Applicants fail to submit a relevant reference, no matter how innocently, a litigator will no doubt charge that the reference was intentionally withheld. After consultation with numerous Patent Counsel and Litigation Counsel on these cases as well as others with similar issues, it has been near universally recommended that the lesser of the evils is to err on the side of over-disclosure – even if the over-disclosure is to the current extremes. Applicants' representatives truly regret that such a large number of references have thus been cited in this application, and further regret that even more references may be disclosed up until issuance of the present application. Accordingly, Applicants most respectfully request full consideration of all references.

Applicant also regrettably submits herewith a further IDS, submission of which was necessitated by receipt of an Office Action in a Chinese counterpart to this application. This IDS cites references and a translated Office Action from this application's Chinese counterpart. Consideration of these references will be greatly appreciated.

Regarding the Rejection Under 35 U.S.C. § 103(a)

Claims 1-2, 7, 8, 15-20, 29-30, and 34-37 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over US Patent Application Publication 2003/0026423 to Unger et al. (hereinafter "Unger"), in view of US Patent Number 6,415,031 to Colligan et al. (hereinafter "Colligan"). This rejection is respectfully traversed.

For the Patent Office to combine references in an obviousness rejection, the Patent Office must first establish *prima facie* obviousness by showing where each and every element is taught or suggested in the combined references. MPEP § 2143.03. This is fundamental to an analysis under the factual inquiries required by *Graham v. John Deere*, 383 U. S. 1 (Supreme Court, 1966) as a part of identification of the scope and content of the prior art. The Patent Office has failed

to do so in the present rejection. Multiple claim elements are missing from the combination of Unger and Colligan, and the Patent Office has failed to provide any articulated reasoning as to why one of ordinary skill in the art would find the claims as a whole to be obvious in the absence of the claim features not present in the cited art (See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006), as explicitly endorsed by the Supreme Court). Such an analysis is required in order to satisfy the factual inquiry ascertaining the differences between the prior art and the claims at issue. Accordingly, the Patent Office has failed to establish *prima facie* obviousness and the present rejection should be withdrawn.

Regarding the rejection of claim 1, Applicant has amended claim 1 to clarify that content encrypted using a first encryption system is stored along with duplicate copies of the encrypted packets at a video on demand (VOD) server. Claim 1 also recites, among other things, stripping out encrypted content having the identifiable duplicate selected packets and encrypting the duplicate copies using a second encryption system in response to receipt of a request for the content from a device that uses the second encryption system. As such, multiple encryption systems are supported within a VOD system in response to a request for content. No new matter has been added. Support for the amendments is found within cancelled claims 11, 14, 15, and within the Specification on page 24, lines 10-20. Claims 3, 6, 8, 10, 12, 13, and 21 were amended for antecedent basis. No new matter has been added.

Applicant has reviewed the cited sections of the Unger reference and the Colligan reference and finds no teaching or suggestion, either alone or in combination, of Applicant's claimed encryption of duplicate selected packets using a second encryption system in response to a request for the content from a device that uses the second encryption system. Applicant further finds no teaching or suggestion of stripping out the encrypted content having the identifiable duplicate selected packets in response to a request for the content from a device that uses the second encryption system. Accordingly, the Patent Office has not shown where each and every element of claim 1 is found within the combination of references and the rejection of claim 1 should be withdrawn for at least these reasons.

Claims 2-10, 12, 13, and 18-21 depend, either directly or indirectly, from claim 1. Accordingly, the rejection of claims 2-10, 12, 13, and 18-21 should be withdrawn for at least the

same reasons as claim 1. Applicant respectfully submits that claims 1-10, 12, 13, and 18-21 are in condition for allowance and notice of the same is requested at the earliest possible date. Applicant reserves the right to provide additional arguments against the rejection of these claims in the future if needed. In view of the above, reconsideration and allowance are respectfully requested.

Applicant additionally notes that the Patent Office appears to have taken Official Notice to formulate this rejection of claims 18 and 19. Applicant hereby requests that proof in compliance with MPEP 2144.04 be provided of the information being noticed. Per MPEP 2144.04, “Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. ... [A]ssertion of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. ... Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. ... Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner’s conclusion should be judiciously applied. Furthermore, ... any facts so noticed should be of notorious character and serve only to ‘fill in the gaps’ in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection.” (Citations omitted, emphasis added).

In the present case, the undersigned is not aware of any teaching of adjusting a program clock reference (PCR) or deleting NULL packets in response to stripping out encrypted content having the identifiable duplicate selected packets and encrypting duplicate copies using the second encryption system being known in the art performed in response to receiving a request for the content from a device that uses a second encryption system. Moreover, the undersigned respectfully submits that it is at least not so notoriously well known as to meet the requirements for Official Notice as outlined above. Hence, Applicant respectfully requests proof of the assertion of Official Notice or withdrawal of same and allowance of claims 18 and 19.

Regarding the rejection of claim 29, Applicant has amended claim 29 to recite, among other things that the system includes an add/drop re-multiplexer deletes encrypted packets encrypted under a first encryption system in response to receiving a request for the content from a target receiver that uses a second encryption system and a session based encrypter that encrypts duplicate copies using the second encryption system in response to the request for the content from the target receiver that uses the second encryption system. As such, the system supports multiple encryption systems in response to a request for content. No new matter has been added. Support for the amendments is found within cancelled claims 35 and 36 and within the Specification on page 24, lines 10-20. Claims 32, 37, and 38 were amended for antecedent basis. No new matter has been added.

Applicant has reviewed the cited sections of the Unger reference and the Colligan reference and finds no teaching or suggestion, either alone or in combination, of Applicant's claimed system that encrypts duplicate selected packets using a second encryption system in response to a request for the content from a target receiver that uses the second encryption system. Applicant further finds no teaching or suggestion of stripping out the encrypted content having the identifiable duplicate selected packets in response to a request for the content from a target receiver that uses the second encryption system. Accordingly, the Patent Office has not shown where each and every element of claim 29 is found within the combination of references and the rejection of claim 1 should be withdrawn for at least these reasons.

Claims 30-34 and 37 depend, either directly or indirectly, from claim 29. Accordingly, the rejection of claims 30-34 and 37 should be withdrawn for at least the same reasons as claim 29. Applicant respectfully submits that claims 29-34 and 37 are in condition for allowance and notice of the same is requested at the earliest possible date. Applicant reserves the right to provide additional arguments against the rejection of these claims in the future if needed. In view of the above, reconsideration and allowance are respectfully requested.

Claims 3-6, 9-14, 21-28, 31-33, and 38 were rejected under 35 U.S.C § 103(a) as allegedly being obvious over the combination of Unger and Colligan as applied to claim 1 above, and further in view of U.S. Patent Application Publication 2003/0118243 to Sezer et al., (hereinafter "Sezer"). This rejection is respectfully traversed. The standards for establishing

prima facie obviousness are set forth above. Applicant respectfully submits that the Patent Office has failed to establish a *prima facie* case of obviousness with the present rejection.

Claims 3-6, 9, 10, 12-13, and 21 depend, either directly or indirectly, from claim 1. Accordingly, the rejection of claims 3-6, 9, 10, 12-13, and 21 should be withdrawn for at least the same reasons as claim 1. Applicant respectfully submits that claims 1, 3-6, 9, 10, 12-13, and 21 are in condition for allowance and notice of the same is requested at the earliest possible date. Applicant reserves the right to provide additional arguments against the rejection of these claims in the future if needed. In view of the above, reconsideration and allowance are respectfully requested.

Regarding the rejection of claim 22, Applicant has amended claim 22 to clarify that content encrypted using a first encryption system is stored along with duplicate copies of the encrypted packets at a video on demand (VOD) server. Claim 22 also recites, among other things, stripping out encrypted content having the identifiable duplicate selected packets and encrypting the duplicate copies using a second encryption system in response to receipt of a request for the content from a device that uses the second encryption system. As such, multiple encryption systems are supported within a VOD system in response to a request for content. No new matter has been added. Support for the amendments is found within cancelled claims 11, 14, 15, and within the Specification on page 24, lines 10-20. Claims 25 and 28 were amended for antecedent basis. No new matter has been added.

Applicant has reviewed the cited sections of the Unger reference, the Colligan reference, and the Sezer reference and finds no teaching or suggestion, either alone or in combination, of Applicant's claimed encryption of duplicate selected packets using a second encryption system in response to a request for the content from a device that uses the second encryption system. Applicant further finds no teaching or suggestion of stripping out the encrypted content having the identifiable duplicate selected packets in response to a request for the content from a device that uses the second encryption system. Accordingly, the Patent Office has not shown where each and every element of claim 22 is found within the combination of references and the rejection of claim 22 should be withdrawn for at least these reasons.

Claims 23, 25, 27, and 28 depend, either directly or indirectly, from claim 22. Accordingly, the rejection of claims 23, 25, 27, and 28 should be withdrawn for at least the same reasons as claim 22. Applicant respectfully submits that claims 22, 23, 25, 27, and 28 are in condition for allowance and notice of the same is requested at the earliest possible date. Applicant reserves the right to provide additional arguments against the rejection of these claims in the future if needed. In view of the above, reconsideration and allowance are respectfully requested.

New Claims

Applicant has submitted herewith new claims 39-41 for the Examiner's consideration. Support for claims 39-41 is found within the Specification on page 22, lines 5-6.

Concluding Remarks

In view of the discussion above, claims 1-10, 12, 13, 18-23, 25, 27-34, and 37-41 are now in proper condition for allowance. Reconsideration is respectfully requested and notice of allowance for all pending claims is respectfully requested at the earliest possible date.

If any issues remain, the Examiner is again encouraged to contact the undersigned to expedite allowance and issue and avoid the necessity and expense of appeal.

Respectfully submitted,

/Jerry A. Miller 30779/
Jerry A. Miller
Registration No. 30,779

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Please Send Correspondence to:
Jerry A. Miller
Miller Patent Services
2500 Dockery Lane
Raleigh, NC 27606
Phone: (919) 816-9981
Fax: (919) 816-9982
Customer Number 24337

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